

### **ARGUMENTS/REMARKS**

Applicants would like to thank the examiner for the careful consideration given the present application, and for the telephone interviews conducted in this case. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

The Examiner rejected claims 3, 47, 67-71 under 35 U.S.C. §112, second paragraph, for being indefinite. Claim 3 has been amended to address the Examiner's rejection for indefiniteness. The rejection of claims 47 and 67-71 are traversed for the following reasons:

The Examiner rejected claims 47 and 67-71 because those claims have a preamble claiming a computer readable medium having a program for executing the method of the parent claims. The Examiner considers these claims improper because they refer back to a different class of invention, and that these claims must stand alone. However, the Examiner has cited no authority for such a rejection. In fact, there is nothing improper about a product claim referring back to a method claim, or vice versa. MPEP §821.04, discussing "Rejoinder" makes clear that it is proper for a method claim to refer back to a product claim, thus, by analogy, the converse is true as well. Such claims as those rejected do not increase the Examiner's workload, because they share the same claim limitations as the parent claim. Accordingly, this rejection is improper. If the Examiner wishes to maintain this rejection, the Examiner is requested to cite the authority for any such rejection. Otherwise, the Examiner is requested to withdraw his rejection.

Claims 1-19 were objected to for using the term "system" in the preamble of the claims. The Examiner states that the term "system" is vague and indefinite, because a "system" could be a process or an apparatus, for example. Any term taken out of context might be considered "indefinite". The application of the term "system", as used in these claims, is not indefinite because the claim elements and limitations clarify the use of the term. The classification of the invention requires that the entire claim be interpreted, not just the preamble. Applicant knows of no requirement that the preamble be restricted to using statutory classes. Applicant does not traverse the Examiner's statutory class designation of apparatus for the purposes of this examination.

Claims 1-8, 14-19, 21, 23-30, 32, 39-46, 48-53, and 68-71 were rejected under 35 U.S.C. §103(a) as being unpatentable over Williams et al. (U.S. 6,016,484) in view of Walker

et al. (U.S. 6,240,396). For the following reasons, the rejection is respectfully traversed.

Claim 1 recites “issuance means for issuing an exchange certificate verifying a user's right to receive the electronic asset, **and also for** issuing the electronic asset corresponding to the exchange certificate.” (lines 5-7, emphasis added), wherein the electronic asset is transmitted at a **predetermined date and time** by a server (lines 3-4 & 9-10, emphasis added). Claims 39, 41, and 43 contain similar limitations as claim 1. Claim 3 describes an exchange certificate being **exchanged** for an electronic asset (lines 9-10). Claims 23 and 41 contain similar limitations as claim 3.

Neither reference teaches any similar issuance or server means as claim 1, or any exchange means of claim 3. Williams does not teach the issuance of an exchange certificate and an electronic asset (claim 1). Further, Williams does not teach an exchange certificate which can be exchanged for an electronic asset. Neither does Williams suggest transmitting the electronic asset at a predetermined date and time (claims 1). Instead, Williams suggests only a real-time transmission of electronic assets which is not predetermined.

Walker does not overcome the Williams’ shortcomings. Walker teaches a means for facilitating the buying and selling of tickets between buyers and sellers. Walker does not suggest a system for issuing exchange certificates and allowing them to be exchanged for electronic assets.

Walker does not teach any issuance means for issuing **both** an exchange certificate **and** an electronic asset, as required by claim 1. The Examiner cites the “conditional offer” as being an exchange certificate and the “guaranteed purchase offer” as being an electronic asset (both shown in FIG. 1 of Walker). However, Walker does not suggest that both of these elements are issued by an issuance means. Instead, the “guaranteed purchase offer” is issued by the potential purchaser user (col. 7, lines 58-60 and FIG. 7b). The offer is guaranteed because the purchaser cannot back out of the offer to purchase if the offer is accepted. In contrast, the “conditional offer” is issued by the network to potential seller users. It is basically made up of a collection of “guaranteed purchase offers” from various potential purchasers (see figure 7b and col. 8, lines 1-10). The offer is “conditional” because the seller may choose whether to accept it or not (id). Accordingly, the “guaranteed purchase offer” of Walker is issued by a different entity than the “conditional offer”.

Hence, Walker does not teach an “issuance means” for issuing **both** the exchange certificate, **and** the electronic asset, as recited in the claim.

Further, Walker does not suggest issuing an electronic asset at a **predetermined date**

**and time** (as recited in claim 1). Instead, Walker suggests only a real-time transmission of items that are transmitted when offered and/or accepted, which is not a **predetermined** time.

Even further, it is clear that there is no “exchange” of the “guaranteed purchase offer” and the “conditional offer” as required by the plain claim 3 language. An offer is exchange for an acceptance. One offer is not exchanged for another offer. But even if one reads Walker as suggesting an offer being exchanged for a counter offer, these are done by the purchaser and seller, not the system itself, which does not issue either the offer or any counter offer or acceptance.

The Walker system merely provides the means for transporting the offer from the purchaser to the seller, and the acceptance from the seller to the purchaser, along with validation activities. It does not “issue” any offers or acceptances. At most, the “ticket code” transmitted by Walker might be considered an electronic asset. But there is nothing analogous to the exchange certificate of the invention.

Accordingly, the combination of Williams with Walker does not teach all of the elements of claims 1, & 3, and thus those claims are patentable over the references, even if combined. If the Examiner wishes to maintain these rejections, the Examiner is requested to specify exactly where the references teach the disputed limitations.

Claim 14 describes the submittal of a receipt certificate being used to trigger the issuing (i.e., an exchange) of a corresponding electronic asset (lines 10-15). Claim 23 recites an “an exchange step of exchanging the exchange certificate for electronic asset corresponding to the exchange certificate” (lines 6-7). Claim 25 recites an “issuance step of issuing an exchange certificate capable of being exchanged for the electronic asset” (lines 9-11). Claim 31 recites “an electronic asset issuance step of issuing the electronic asset corresponding to [a previously submitted] receipt certificate” (lines 13-15 & 20-21). Claim 39 recites “issuance means which, after the settlement processing means has settled the charge, issues an exchange certificate verifying a user's right to receive the electronic asset and which also issues the electronic asset corresponding to an exchange certificate” (lines 5-8). Claim 41 describes an exchange certificate being submitted to a server and an electronic asset being transmitted as a result (lines 12-15). Claim 42 describes a receipt certificate being submitted to a server and an electronic asset being issued and transmitted as a result (lines 10-16), which is not taught by the references. Claim 43 describes an issuance means issuing both an exchange certificate and an electronic asset (lines 3-5). Claim 45 describes an exchange certificate being exchanged for an electronic asset (lines 6-14). Claim 46 recites

"issuance means issues the electronic asset corresponding to the [previously submitted] receipt certificate (lines 11-12 & 14-15). As discussed in relation to claim 1 and/or claim 3, above, the cited references do not teach issuance of *both* an exchange certificate (or a receipt certificate) *and* an electronic asset, nor do the references teach that the certificate is *exchanged* for (or its submission triggers the issuance of) an electronic asset. Consequently, claims 1, 3, 14, 23, 25, 31, 39, 41, 42, 43, 45, and 46 are all patentable over the cited references. The remaining claims all depend, directly or indirectly, on one of these claims, and are thus also patentable over the references.

Finally, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

The Examiner has not cited any proper motivation to modify the reference. Conclusory statements of benefit, such as the ones provided by the Examiner in the Office action, are not sufficient to show obviousness. Merely listing an advantage of the combination is not sufficient, as some rationale for combining the references must be found in the references, or drawn from a convincing line of reasoning based on established scientific principles that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph). Because the Examiner has not provided the proper motivation for combining the references, the combination is improper and hence the rejection cannot stand.

Claims 9-13, 22, 32, 38, 47, 54, 72-83 were rejected under 35 U.S.C. §103(a) as being unpatentable over Williams in view of Walker in further view of Hughes et al. (U.S. 5,982,893). For the following reasons, the rejection is respectfully traversed:

Hughes does not overcome the shortcomings of Williams combined with Walker identified above (i.e., Hughes does not teach issuance of *both* an exchange certificate *and* an electronic asset, their exchange, or the issuance at a predetermined time). Further, the Examiner has not provided the proper motivation for combining the references. Accordingly,

these claims are patentable over the references for the same or similar reasons as claims 1, and 3.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32410.

Respectfully submitted,

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